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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |  |  |
|--|-------------|----------------------|---------------------|------------------|--|--|
| 10/784,485   | 02/20/2004  | Michael L. Howard    | 2291.2.9.2          | 2179             |  |  |
| 21552  | 7590        | 01/23/2009           | EXAMINER            |                  |  |  |
| AUSTIN RAPP & HARDMAN<br>15 WEST SOUTH TEMPLE<br>SUITE 900<br>SALT LAKE CITY, UT 84101 |             |                      | NGUYEN, TANH Q      |                  |  |  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |  |  |
| 2182   |             |                      |                     |                  |  |  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |  |  |
| 01/23/2009   |             | PAPER                |                     |                  |  |  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                              |                                   |
|------------------------------|------------------------------|-----------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b>       | <b>Applicant(s)</b>               |
|                              | 10/784,485<br>TANH Q. NGUYEN | HOWARD ET AL.<br>Art Unit<br>2182 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 November 2008 (RCE).  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 20 May 2008 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 20, 2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al. (US 5,623,604) in view of Lieu et al. (US 6,708,045); and alternatively as being unpatentable over Russell et al. in view of Cole et al. (US 6,074,434), and further in view of Lieu et al..

4. As per claim 1, Russell teaches a communications adapter [2, FIG. 1; FIG. 4] for facilitating electronic communications with an electronic device [4, FIG. 1] wherein the adapter is remotely reprogrammable by a provider computer [14, FIG. 1] through a communications network [6, FIG. 1], the adapter comprising:

a communications port [226, FIG. 4] for electronically connecting the adapter to the electronic device, wherein the adapter does not comprise a user interface with a display that is integrated as a part of the adapter;

communications hardware [202, 203, 204, 206, 208 – FIG. 4] for communicating automatically with the provider computer through the communications network;

a processor [216, FIG. 4]; and

memory [220, 222, 228, 230 – FIG. 4] programmed to cause the adapter to send an identification of the adapter to the provider computer via the communications network [col. 33, lines 34-37; col. 35, lines 5-10; 232 – FIG. 4] and to receive new data sent by the provider computer via the communications network to update a program of the adapter [S36, FIG. 5C; S1619, FIG. 16B; FIG. 20; FIG. 24], wherein the new data comprises device instructions for the processor for communicating with the electronic device through the communications port [col. 1, line 61-col. 2, line 33], wherein the adapter is a handheld device that comprises a single-board computer [2, FIG. 3; FIG. 4;

Art Unit: 2182

col. 10, lines 42-45].

Russell also teaches the memory programmed to cause the adapter to send information to the provider computer to facilitate identification of appropriate device instructions for communicating with the electronic device (i.e. to send current information to facilitate identification of appropriate modifications to device instructions for communicating with the electronic device: col. 33, lines 34-37; col. 33, line 41-col. 34, line 29; col. 35, lines 5-10; col. 35, line 17-col. 39, line 39).

Alternatively, Cole teaches sending information (basic information) to a provider computer (col. 4, lines 36-39) to facilitate identification of appropriate device instructions (device driver) for communicating with an electronic device in order to eliminate inappropriate device instructions from being identified (col. 4, lines 41-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the adapter of Russell to send its basic information to the provider computer to facilitate identification of appropriate device instructions for communicating with the electronic device in order to eliminate inappropriate device instructions from being identified – as is suggested by Cole.

Russell, alone or in combination with Cole, does not specifically teach the communications network being a wireless network.

Lieu teaches wireless communications obviating the need for in-building wiring and cabling [col. 1, lines 15-28]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Russell's adapter in a wireless network environment because wireless communications obviate the need for in-building

Art Unit: 2182

wiring and cabling – as suggested by Lieu.

5.     As per claims 2-4, Lieu teaches the wireless network being a pager network, and the wireless network being cellular network [col. 1, lines 14-16]. Also, since it was known for cellular network and pager network to be global communications network for worldwide coverage [e.g. Lindgren (US 6,163,274) at col. 3, lines 46-48], it would have been obvious to one of ordinary skill in the art that for the wireless network to be a global communications network in order to be able to have world-wide communications.

6.     As per claims 5-6, Russell teaches the new data comprising a translator that includes an object representation of the electronic device, a translator that includes a functional representation of the electronic device [the update program is a translator that provides a new representation of the electronic device: col. 1, lines 11-20].

7.     As per claim 7, Russell teaches the memory being programmed to cause the adapter to identify the electronic device and to further send an identification of the electronic device to the provider computer via the communications network [col. 8, lines 45-50].

8.     As per claims 8-12, the claims generally correspond to claims 1-2, 5-7 with the electronic device having an external communications port [100, 102 - FIG. 3], and the new instructions being used for communications with the electronic device without altering any program code on the electronic device (no alteration necessary on the printer) - and are therefore rejected on the same bases.

9.     As per claims 13-14, the claims generally correspond to claims 1-2 with the adapter connected to an external communications port of the electronic device [100,

102 - FIG. 3], establishing communications with the provider computer [col. 2, lines 49-51] - and are therefore rejected on the same bases.

10. As per claim 15, see the rejections of claims 1, 8 above.

### ***Response to Arguments***

11. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TANH Q. NGUYEN whose telephone number is (571)272-4154. The examiner can normally be reached on M-F (9:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TARIQ HAFIZ can be reached on (571)272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Application/Control Number: 10/784,485  
Art Unit: 2182

Page 7

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TANH Q. NGUYEN/  
Primary Examiner, Art Unit 2182

TQN: January 21, 2009